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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91226028
Party	Defendant Allstate Insurance Company
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Administration America LLC,)	
Financial Gap Administrator LLC,)	
Vehicle Service Administrator LLC,)	Opp. No. 91226028
Wise F&I, LLC)	
)	Directed to U.S. Ser. No. 86/668,531
Opposer,)	
)	Mark: MILEWISE
vs.)	
)	
Allstate Insurance Company)	
)	
Applicant.		

MOTION TO DISMISS

The Notice of Opposition filed by Opposers alleges only that the Applicant’s mark resembles an alleged family of marks. However, it fails to properly allege that the marks constitute a family. Accordingly, Applicant Allstate Insurance Company (“Allstate”) respectfully requests that the opposition be dismissed for failure to state a claim pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure.

I. BACKGROUND

Applicant filed an application to register the mark MILEWISE, Serial No. 86/668,531 (“Applicant’s Mark”) on June 19, 2015. The application published on September 29, 2015.

Opposers claim rights to an alleged family of marks. Paragraph 7 is the sole portion of the Notice of Opposition directed to identifying the features of the alleged family of marks. *See* Notice of Opposition. That paragraph states that “Opposers began using, and have continuously used in interstate commerce, a family of WISE marks wherein the term WISE is the family indicator” in connection with automotive finance and insurance products and services and other products and services. Paragraph 7 also alleges that “the marks have become well known and

famous to consumers.” The marks identified in the Notice of Opposition (“the Identified Marks”) use the word WISE as a prefix, a suffix, and, in some cases, a separate word.

The Identified Marks are not commonly owned. Rather, the ownership of the Identified Marks as set forth in the TDSR reports attached to the Notice is reflected in the table below. Opposers admit that Administration America LLC, Financial Gap Administrator LLC, and Vehicle Service Administrator LLC are separate subsidiaries of Wise F&I LLC Limited Liability Co. *See* Notice of Opposition, at ¶ 5.

Registration/Serial Number	Mark	Owner
4778223	ONWISE	Wise F&I LLC Limited Liability Co.
4249179	WISE F&I	Wise F&I LLC Limited Liability Co.
3611703	ID THEFTWISE	Administration America LLC
3086022	THEFTWISE	Administration America LLC
2745080	ETCHWISE	Administration America LLC
86625442	KEYWISE	Administration America LLC
2363547	GAPWISE	Financial Gap Administrator LLC
4372307	WISECARE	Vehicle Service Administrator LLC
2800305	TIREWISE	Vehicle Service Administrator LLC
N/A	WISETVP	unknown

II. LEGAL STANDARD

A motion to dismiss for failure to state a claim “is a test solely of the legal sufficiency of a complaint.” *See* § 503.02 of the Trademark Trial and Appeal Board Manual of Examining Procedure (TBMP). Under FRCP 12(b)(6), the Board must dismiss an opposition if it fails to state a claim that is “plausible on its face.” T.B.M.P. § 503.02 (citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). “Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). The purpose of FRCP 12(b)(6) “is to allow the court to eliminate actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity.” *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 26

U.S.P.Q.2d 1038, 1041 (Fed. Cir. 1993). When ruling on a motion to dismiss, the Board shall accept factual allegations pled in the opposition as true, but “[c]onclusory allegations of law and unwarranted inferences of fact do not suffice to support a claim.” *Bradley v. Chiron Corp.*, 45 U.S.P.Q.2d 1819, 1822 (Fed. Cir. 1998).

Deciding a Rule 12(b)(6) motion is a “context-specific task” that requires an analysis of the plead facts in light of the specific elements of the cause of action alleged. *In re Bill of Lading Transmission and Processing System Patent Litigation*, 103 U.S.P.Q.2d 1045, 1059 (Fed. Cir. 2012) (quoting *Iqbal*, 556 U.S. at 679).

To establish ownership of a family of marks, one must prove that a group of marks has a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. *J&J Snack Foods Corp. v. McDonald’s Corp.*, 18 U.S.P.Q.2d 1889, 1891 (Fed. Cir. 1991). Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. *Id.* The existence of a family of marks is a question of fact based on the distinctiveness of the common formative component, the extent of the family’s use, advertising, promotion, and its inclusion in a number of registered and unregistered marks owned by a single party. *McDonald’s Corp. v. McBagel’s Inc.*, 1 U.S.P.Q.2d 1761, 1763 (S.D.N.Y. 1986). The marks must create recognition of “common ownership based upon a feature common to each mark” and that common feature must be the distinguishing feature of each mark, not a merely descriptive or suggestive portion of the mark. *American Standard Inc. v. Scott & Fetzer Co.*, 200 U.S.P.Q. 457, 461 (TTAB 1978).

III. ANALYSIS

Opposers have not properly pled the elements of a claim for likelihood of confusion based upon ownership of a family of marks. Because that is the only claim made by Opposers, the Opposition should be dismissed.

A. The Marks Do Not Share a Common Owner

The existence of a family of marks requires that the public associate not only the individual marks, but the common feature of the family of marks with “the trademark owner.” *J&J Snack Foods Corp. v. McDonald’s Corp.*, 18 U.S.P.Q.2d 1889, 1891 (Fed. Cir. 1991). The marks must create recognition of “common ownership based upon a feature common to each mark.” *American Standard Inc. v. Scott & Fetzer Co.*, 200 U.S.P.Q. 457, 461-62 (TTAB 1978); *see also McDonald’s Corp. v. McBagel’s Inc.*, 1 U.S.P.Q.2d 1761, 1763 (S.D.N.Y. 1986) (stating that a family of marks is “owned by a single party”).

Here, Opposers have not and cannot allege that the marks are owned by a single party and share a common ownership. To the contrary, each Opposer owns between 1 and 4 of the marks alleged to constitute “a family”. Opposers enjoy the advantage, whatever it may be, of this diffuse ownership scheme for the various claimed marks, but have alleged no basis on which the marks can be viewed to be owned by a single party and thus considered a “family.” The Opposers make no plausible claim that the Identified Marks are associated with a particular owner and as a result constitute a family of marks. Likelihood of confusion cannot therefore be found on the basis that such a family exists.

B. Opposer Has Not Alleged Facts to Support Its Claim that the Marks Constitute a Family of Marks

Opposers make conclusory statements that the Identified Marks are a family, that the term WISE is the family indicator, and that the marks have become well known and famous to

consumers. Notice of Opposition at ¶ 7. These allegations are not sufficient to plausibly allege that the Identified Marks constitute a family.

The statement that “Opposers began using, and have continuously used in interstate commerce, a family of WISE marks” is nothing more than a conclusory statement that the marks constitute a family. *See Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). Similarly, stating that the term WISE is the family indicator is a conclusory statement that it suffices to indicate a family. Mere ownership of a number of registrations for marks having a common feature does not establish that the registrant is the owner of a “family of marks”. *Burroughs Wellcome & Company (U.S.A.) Inc. v. Mezger Pharmacal Company, Inc.*, 108 U.S.P.Q. 130, 131 (CCPA, 1955); *Lauritzen & Company, Inc. v. The Borden Company*, 112 U.S.P.Q. 60, 61 (CCPA, 1956). Nor does the alleged fact that the marks have been used in the marketplace in and of itself establish that Opposers are entitled to such relief as may be afforded under the theory of “family of marks”. *The Creamette Company v. Porter-Scarpelli Macaroni Co.*, 128 U.S.P.Q. 130, 131 (TTAB 1961).

Instead, Opposers must allege that a group of marks has a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. *J&J Snack Foods Corp. v. McDonald’s Corp.*, 18 U.S.P.Q.2d 1889, 1891 (Fed. Cir. 1991). The common characteristic must be distinctive, not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party’s mark. *American Standard Inc. v. Scott & Fetzer Co.*, 200 U.S.P.Q. 457, 461-62 (TTAB 1978).

Here, Opposers have not made any such allegations regarding the distinctiveness of the common feature or consumer recognition of that feature as being distinctive of a common owner.

Accordingly, Opposers have made no plausible claim that a likelihood of confusion exists between the Applicant's Mark and the alleged WISE family of marks.

IV. CONCLUSION

Opposers have failed to meet the *Twombly* standard for asserting their claim. While the Board must accept the pleaded facts as true for purposes of Applicant's motion, Opposer is still obliged to allege the facts necessary to state a claim. Opposers have not alleged that the Identified Marks are owned by a single owner or that the Identified Marks share a distinctive, recognizable common characteristic, and are used in such a way that the public associates not only the individual marks, but the common characteristic of the "family," with a single owner. Accordingly, Allstate respectfully requests that the Board grant its motion to dismiss the Opposition under Rule 12(b)(6).

Respectfully submitted,

Dated: April 6, 2016

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was sent, by agreement of the parties, via email on April 6, 2016, to the following:

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